

Claim Rejections under 35 USC §112

The claims have been amended to more clearly define the subject matter of the invention and to hopefully remove any objections the Examiner may have as to clarity of language. Should the Examiner have suggestions which might further clarify the claims and the patentable subject matter of the invention the Applicant would be most receptive to such.

Claim Rejections under 35 USC §102(b) per Church

The Examiner has objected to claims 1-3 and 6-8 as anticipated by Church (6,572,871).

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." ***Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.***, 221 USPQ 481, 485 (Fed. Cir. 1984)

The Examiner may have misunderstood the construction of Church. The Examiner indicates in the last line of page 4 of the office action, that Church has an herbal pack. No such component exists in Church.

The Examiner states at Column 1, lines 50-55 of Church indicates that the temperature generated by the Church heating pad is stated sufficient to vaporize the herbs contained in the herbal pack.

What column 1, lines 50-55 does state, is that there is no herbal pack in Church separated from the skin by a permeable barrier as in applicant's device.

Instead, Church states on line 45-55 that various heating means may be used for covering the area affected, on which a *topically-applied* analgesic cream, (which is the subject of the invention) has already been applied directly onto to the skin surface.

Church is applying a cream directly onto the skin. Unlike applicant's device, which keeps the herbs out of contact with the skin directly, and only allows vapors communicated through a vapor permeable barrier and thereby separates and prevents contact of the actual herbs with the skin, Church simply rubs cream on the skin and applies a heat pack.

Applicant device is an herbal applicator adapted to generate vapors from internally stored herbs and then communicate those vapors through a permeable layer to the skin of the user.

The device of applicant employs a flexible housing which can be easily attached onto the user's body, which is engaged with a flexible heating pad which is regulated to generate heat at a determined temperature.

Unlike the cited device which places a cream on the skin, and then places a sleeve between the heating pad and the cream, applicant's device places an herbal pack in contact with the housing-engaged heating pad, and then places a flexible retainer layer that is permeable to hold the herbal pack, separated from the user's skin, and adjacent to the heating pad.

The herbal pack is made in applicant's device to be easily removable from the herbal pack retainer which separates the herbal pack from the skin to replenish the herbal pack which is sandwiched between the heating pad and the permeable layer of the herbal pack retainer and thereby keeps the herbal pack away from the skin of the user.

Instead of applying a cream or gel directly to the skin as in Church, applicant's device employing the separated herbal pack which is in direct contact with the heating pad, and heats the herbal pack to generate a vapor from the herbs. The vapor will pass through the barrier formed by the retainer and communicate with the skin, only when the herbs inside the Herbal Pack are heated sufficiently.

As such, the applicant's device has structure, providing function to applicant's device, neither of which is taught or suggested by Church.

Church lacks any herbal pack. Church lacks the sandwiched engagement of the herbal pack between the removable herbal pack retainer and the heating pad. Church lacks the barrier of the herbal pack retainer which prevents direct continuous contact of the herbs with the skin. Church lacks the permeable layer adapted to communicate herb vapors, from behind the barrier, through it and to the skin.

Instead, Church is a simple structure employing the conventional application of a gel or cream, directly on the skin, and then applying a heat pack, perhaps with a sleeve on it.

Lacking an herbal pack, and lacking the engagement of the herbal pack between a heater and a retainer layer that keeps the herbal pack from contacting the skin at all, and lacking the generation of vapors from the herbal pack (not a sponge) which only communicate through the retainer layer when the heating pad is hot, Church lacks multiple elements and functions of those elements that applicant's device provides.

Church thus as noted above, thus lacks elements of Applicant's device and the function provided by those elements and the objection pursuant to Section 102 is respectfully traversed.

Claim Rejections under 35 USC §102 per Smith

Claims 1-8 have been rejected pursuant to 102(e) per the pending application of Smith (US2003/0069618). The Examiner cites numerous elements thought to exist in Smith, however nowhere does the Examiner provide numbers relating the drawings in Smith which purport to show the elements noted by the Examiner. The paragraphs noted by the Examiner do not denote elements of applicant's claimed invention which are missing from Smith. Applicant can find no numerals in the drawings or specifications which denote or show the missing elements noted above in Church.

The Examiner indicates somewhere that Smith has an herbal pack. Applicant cannot find a reference to one in Smith in the cited text, and the Examiner has given no indication of where in the drawings of Smith such an herbal pack exists.

Further, Smith, just like Church is a heating pad that can be applied after a topical mixture is applied directly onto the skin of the user. There is no herbal pack in Smith. There is no engagement of the herbal pack between a heater and a retainer layer in Smith. There is no retainer layer in Smith that separates the herbal pack from contacting the skin of the user

and no permeable layer formed in Smith to maintain the herbal pack separated from the skin and which is permeable enough to pass only vapors from the separated herbal pack.

None of these elements appear in the drawings of Smith, nor the cited text of Smith and the Examiner has not pointed out any numerals in the drawings that identifies these missing elements.

Lacking elements, and the function thereof, which is claimed I applicant's application, the objection per section 102 based on Smith is respectfully traversed.

Claim Rejections under 35 USC §103 per Church in view of Smith

The Examiner has rejected claims 1-8, per Church combined with Smith indicating it to be an obvious combination to yield all the claimed elements of Applicant's device.

As shown above, Church lacks structure and elements of Applicant's claimed invention and the provided functions of those elements. The same elements are missing from Smith and nowhere in either cited reference do the elements appear or are they suggested.

Consequently the suggested combination of Smith and Church, is respectfully traversed.

Final Remarks

As noted above, Applicant's device claims elements providing function, which are neither taught nor suggested in the cited in any of the cited prior art. These elements were included in the original claims and are still included in the amended claims so no new search should be necessary.

Further, Applicant as noted in the specification considers the improvement to be substantial and provide great benefits in the area in this area of art and the contact of herb vapors only with the skin of a user. The art is crowded however applicant still believes the improvement provided to be significant.

However, even if the Examiner does not consider Applicant's claimed device a great advance in the art of herbal vapor application, it has been established that one should not be deprived of patent protection where it can be shown that any genuine improvement has been made, on comparison with other inventions in the art - even if the improvement lacks the appearance of a great advance in the art.

In re Lange, 128 USPQ 365, the CCPA on page 367 states that:

"We think that the present application is a distinct improvement of Jezalik and represents an advance in the art not obvious, having patentable novelty. The art is a crowded and comparatively simple on and in such an art, great advances are not to be expected. However patentability will not be denied to an invention which accomplishes a small, but nevertheless genuine improvement not though of by others.."

Further, the CCPA in the recent case of re Meng and Driessen, 181 USPQ 94, on page 97, reiterated the principal that even though the invention seems a simple advance over prior art, after the fact, simplicity, argues *for*, rather than against patentability.

Considering that Applicant's device has combined elements not taught or suggested in the prior art, and that the method and apparatus of imparting herb vapors from heated herbs in a separated easy to replace reservoir herb pack, offers a distinct improvement in the art, especially when compared to the cited topical application of simple creams, and considering that both major and minor improvements in the art argue for patentability, all claims of the patent should now be allowable.

Should the Examiner have any further questions or concerns the Examiner wishes to address, or should the Examiner have suggestions as to language that might more clearly define the invention, the Applicant's attorney would be most receptive to such by telephone.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Donn K. Harms", with a stylized flourish at the end.

Donn K. Harms
Reg No 38,911
Attorney for Applicant

12702 Via Cortina, Ste. 100
Del Mar, CA 9014

Tel: (858) 509-1400